

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons which follow.

After amending the claims as set forth above, claims 71-119 are now pending in this application.

REMARKS

Applicants acknowledge receipt of an Office Action dated October 16, 2002. In this response Applicants have cancelled claims 1-70 without prejudice or disclaimer and have added claims 71-119. Following entry of these amendments, claims 71-119 are pending in the application.

Reconsideration of the present application is respectfully requested in view of the foregoing amendments and the remarks which follow.

Rejections Under 35 U.S.C. § 112, 2nd Paragraph

On page 2 of the Office Action, the PTO has rejected claims 1-30, 32-35, 37, 39 and 43-47 under 35 U.S.C. § 112, 2nd paragraph as allegedly being indefinite. Applicants respectfully traverse this rejection inasmuch as Deputy Commissioner for Patent Examination Policy Stephen G. Kunin has issued new guidance for PTO personnel regarding issuance of rejections under 35 U.S.C. § 112, 2nd paragraph. A copy of these guidelines is provided herewith.

The rejection under § 112 is rendered moot by cancellation of all of the original claims (without prejudice or disclaimer) and replacement of those claims by newly drafted claims 71-79. The new claims have been drafted in more appropriate U.S. style format and are believed to be free from the objections raised in the Office Action when taken in view of the guidelines referenced above.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections under 35 U.S.C. § 112, 2nd paragraph.

Rejections Under 35 U.S.C. § 103

On page 3 of the Office Action, the PTO has rejected claims 1-30, 32-35, 37, 39 and 43-47 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication 2002/00822779 to Schultz (hereafter "Schultz") in view of an English Language Abstract of CN 1113773 to Tu (hereafter "Tu") and in further view of U.S.

Patent 5,110,593 to Benford (hereafter "Benford"). Applicants respectfully traverse this rejection for the reasons set forth below. As an initial matter, Applicants note that the PTO only provided a copy of the abstract of Tu. If the PTO intends to rely upon the document referred to in the English language abstract, Applicants request that the PTO so state for the record and that the PTO provide a copy of the document (CN 1113773) with the next Official Action.

In this response, Applicants have cancelled claims 1-30, 32-35, 37, 39 and 43-47 (without prejudice or disclaimer) and have added claims 71-119 which have been drafted in more appropriate U.S. style format. Accordingly, the rejections of claims 1-30, 32-35, 37, 39 and 43-47 are now moot. Applicants respectfully traverse the rejection of these claims to the extent that the PTO considers applying this rejection to newly added claims 71-119.

Specifically, in order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). See MPEP §2143.03. Here, none of the cited references, namely Schultz, Tu and Benford, taken either individually or in proper combination, teach or fairly suggest the composition of independent claim 1 which comprises "an herbal colourant isolated from a species belonging to the genera of the family *Boraginaceae*". Accordingly, Applicants submit that claim 1 is non-obvious within the meaning of 35 U.S.C. §103.

If an independent claim is nonobvious under §103, then any claim depending therefrom is nonobvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). See MPEP 2143.03. Thus, Applicants submit that claims 71-119 which ultimately depend from claim 1, are also non-obvious.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of this rejection under §103.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that all of the pending claims are now in condition for allowance. An early notice to this effect is earnestly solicited. If there are any questions regarding the application, the Examiner is invited to contact the undersigned at the number below.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date 3/17/03

By 

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Commissioner for Patents
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Memorandum

Date: January 17, 2003

To: Technology Center Directors
Patent Examining Corps

From: Stephen G. Kunin
Deputy Commissioner for Patent Examination Policy

Subject: Advance notice of changes to MPEP § 2173.02 clarifying Office policy with respect to rejections made under 35 U.S.C. § 112, second paragraph in view of the Supreme Court holding in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S.Ct. 1831, 62 USPQ2d 1705 (2002)

This memorandum clarifies Office policy with respect to rejections made under 35 U.S.C. § 112, second paragraph. The guidance provided herein is effective immediately and should be applied by all Office personnel. These changes will be published in the next revision of the MPEP.

As noted in MPEP § 2173.02, during examination of claims for compliance with the requirements for definiteness under 35 U.S.C. § 112, second paragraph, some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. In reviewing a claim for compliance with 35 U.S.C. § 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. § 112, second paragraph by providing clear warning to others as to what constitutes infringement of the patent. See *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. § 112, second paragraph would be appropriate. See *Morton Int'l, Inc. v. Cardinal Chemical Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993). However, if other modes of expression selected by applicants satisfy the statutory requirements of 35 U.S.C. § 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. § 112, second paragraph, rather, the examiner should suggest improved language to the applicant.

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For example, a claim recites "a suitable liquid such as the filtrate of the contaminated liquid to be filtered and solids of a filtering agent such as perlite, cellulose powder, etc." The mere use of the phrase "such as" in the claim does not by itself render the claim indefinite. Office policy is not to employ *per se* rules to make technical rejections. Examples of claim language which have been held to be indefinite set forth in MPEP § 2173.05(d) are fact specific and should not be applied as a *per se* rule. The test for definiteness under 35 U.S.C. § 112, second paragraph is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). If one skilled in the art is able to ascertain in the example above, the meaning of the terms "suitable liquid" and "solids of a filtering agent" in light of the specification, 35 U.S.C. § 112, second paragraph is satisfied.

If upon review of the claim as a whole in light of the specification, the examiner determines that a rejection under 35 U.S.C. § 112, second paragraph is not appropriate in the above-noted example, but is of the opinion that the clarity and the precision of the language can be improved by the deletion of the phrase "such as" in the claim, the examiner may make such a suggestion to the applicant. If applicant does not accept the examiner's suggestion, the examiner should not pursue the issue.

If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. § 112, second paragraph is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is "vague and indefinite" should be included in the Office action. If applicants traverse the rejection, with or without the submission of an amendment, and the examiner considers applicants' arguments to be persuasive, the examiner should indicate in the next Office communication that the previous rejection under 35 U.S.C. § 112, second paragraph has been withdrawn and provide an explanation as to what prompted the change in the examiner's position (e.g., examiners may make specific reference to portions of applicants' remarks that were considered to be the basis as to why the previous rejection was withdrawn).

By providing an explanation as to the action taken, the examiner will enhance the clarity of the prosecution history record. As noted by the Supreme Court in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S.Ct. 1831, 1838, 62 USPQ2d 1705, 1710 (2002), a clear and complete prosecution file record is important in that "[p]rosecution history estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process." In *Festo*, the court held that "a narrowing amendment made to satisfy any requirement of the Patent Act may give rise to an estoppel." With respect to amendments made to comply with the requirements of 35 U.S.C. § 112, the court stated that "[i]f a § 112 amendment is truly cosmetic, then it would not narrow the patent's scope or raise an estoppel. On the other hand, if a § 112 amendment is necessary and narrows the patent's scope—even if only for the purpose of better description—estoppel may apply." *Id.*, at 1840, 62 USPQ2d at 1712. The court further stated that "when the court is unable to determine the purpose underlying a narrowing amendment—and hence a rationale for limiting the estoppel to the surrender of particular equivalents—the court should presume that the patentee surrendered all subject matter between the broader and the narrower language...the patentee should bear the burden of showing that the amendment does not surrender the particular equivalent in question." *Id.*, at 1842, 62 USPQ2d at 1713. Thus, whenever possible, the examiner

should make the record clear by providing explicit reasoning for making or withdrawing any rejection related to 35 U.S.C. § 112, second paragraph.